

REMARKS

Status of the Claims

Claims 1-7 and 9 are now present in this application. Claim 1 is independent.

Claim 1 has been amended. Reconsideration of this application, as amended, is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 1-7 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagamatsu et al., U.S. Patent Application Publication No. 2004/0206199 (hereinafter "Nagamatsu") in view of Kodaira, U.S. Patent No. 6,427,799 (hereinafter "Kodaira"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejections is set forth in the Office Action, and is not repeated herein.

Without conceding to the propriety of the Examiner's rejection, but merely to timely advance the prosecution of the application, as the Examiner will note, independent claim 1 has been amended to more clearly clarify the present invention.

In particular, independent claim 1, as amended, now includes, *inter alia*, the recitation of **"...said first gap substantially overlaps, in an axial direction, with a screwing region between said retaining part and said fixing nut screwed into said retaining part, and wherein said fixing nut is in direct contact with said thrust bearing, and said first gap is larger than a second gap on a part of the spigot-joint fitting part where said first gap is not provided, and within said first gap, an increase in an outer diameter of the retaining part caused when the fixing nut is tightened is absorbed."** Support for the language can be found at least in, for example, Fig. 3 and page 14, line 4 through page 15, line 2 of the Specification as originally filed. Thus, no new

matter has been added. Applicants respectfully submit that the above identified features set forth in claim 1 are not disclosed or suggested by the references relied on by the Examiner.

With regard to the Examiner's reliance on Nagamatsu, it seems that the Examiner referred to the portion where the preload nut 56 screws into the bearing hole 28 as shown in Fig. 3 of Nagamatsu as the screwing region of the present invention, and referred to the joint seam of the housings 21 and 22 of Nagamatsu as the first gap of the present invention. However, as clearly shown in Fig. 3 of Nagamatsu, the screwing portion of the preload nut 56 does **not substantially** overlap the joint seam of the housings 21 and 22; instead, they only partially overlap. Therefore, Applicants respectfully submit that Nagamatsu fails to teach or suggest *"said first gap substantially overlaps, in an axial direction, with a screwing region between said retaining part and said fixing nut screwed into said retaining part, and wherein said fixing nut is in direct contact with said thrust bearing, and said first gap is larger than a second gap on a part of the spigot-joint fitting part where said first gap is not provided, and **within said first gap, an increase in an outer diameter of the retaining part caused when the fixing nut is tightened is absorbed**"* as recited on claim 1.

Further, as mentioned in the last Reply, the first gap substantially overlaps with the screwing region and is larger than a second gap on a part of the spigot-joint fitting part where said first gap is not provided, so that an increase in the outer diameter of the retaining part caused when the fixing nut is tightened into the screwing region can be efficiently absorbed within the range of the first gap. In that case, the problem in the integration of the first housing and the second housing by spigot-joint fitting can therefore be avoided. In view of this, Applicants respectfully submit that the above features of the present invention are **not** merely a matter of design choice, but are non-obvious over the teachings of Nagamatsu.

With regard to the Examiner's reliance on Kodaira, the Examiner on page 3 of the Office Action denoted on Fig. 3 of Kodaira referring to the caulking groove 38 of Kodaira as the first gap of the present invention and asserting that the caulking groove 38 is larger than the normal joint seams, which reads on the present invention. Applicants respectfully disagree.

First, Applicants respectfully submit that the caulking groove 38 clearly does **not substantially** overlap with either of the screwing portions made by the yoke 7 or the bearing hold ring 32. In view of this, it is submitted that Kodaira also fails to teach or suggest “***said first gap substantially overlaps, in an axial direction, with a screwing region between said retaining part and said fixing nut screwed into said retaining part, and wherein said fixing nut is in direct contact with said thrust bearing, and said first gap is larger than a second gap on a part of the spigot-joint fitting part where said first gap is not provided, and within said first gap, an increase in an outer diameter of the retaining part caused when the fixing nut is tightened is absorbed***” as recited in claim 1, and thus fails to cure the deficiency of Nagamatsu.

Second, the Examiner on page 3 of the Office Action asserted “it would have been obvious to a person of ordinary skill in the art to alternatively use the housing and groove of Kodaira with the steering apparatus of Nagamatsu et al. to allow for an adhesive to be applied which allows for a securer fit.” Applicants respectfully disagree with the Examiner’s above rationale.

Specifically, referring to Fig. 2 and the corresponding disclosure of Nagamatsu, it is noted that the first housing 21 and the second housing 22 are connected together by placing connection flanges 25 and 26 provided on the end faces of the respective housing to face each other and tightening a plurality of fixing bolts 27 in a circumferential direction. In this case, the Examiner is respectfully questioned that why one skilled in the art will be led to abandon the above connection fashion and redesign the housings 21, 22 to make the connection in the manner taught in Kodaira. The Examiner is respectfully reminded that obviousness cannot be proven merely by showing that the elements of a claimed composition were known in the prior art; it must be shown that those of ordinary skill in the art would have had some “**apparent reason to combine** the known elements in the fashion claimed.” *KSR Int’l Co. v. Teleflex Inc.* 127 S.Ct. 1727,1741 (2007).

It should be noted that the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious **unless the prior art suggested the desirability of the modification.** In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d

1780, 1783-84 (Fed. Cir. 1992). In this case, the Examiner asserted that the motivation is to apply an adhesive which allows for a securer fit. However, Applicants respectfully submit that this asserted motivation by the Examiner is unreasonable and unpersuasive, because such asserted motivation of “applying an adhesive” does **not** stem from the teaching of Kodaira (since Kodaira teaches a caulking fit through the caulking grooves), and **also is not** desirable for the invention of Nagamatsu. It is unreasonable for one skilled in that art to replace the connection means for the housings 21, 22 in Nagamatsu with the Examiner’s asserted adhesive connection in a steering device. Applicants respectfully submit that in fact, this asserted motivation is merely conclusory statements of the Examiner without objective evidence of record **only in order to** “make” the combination reads on the present invention.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination, which allegedly renders a claim obvious.

In view of the above, it is submitted that the Examiner has not established a *prima facie* basis to deny patentability of the claimed invention under 35 U.S.C. § 103 for want of the requisite factual basis.

Based on the above, Applicants respectfully submit that since Nagamatsu and Kodaira, either taken alone or in combination, fail to teach each and every claimed feature as recited in claim 1, claim 1 clearly defines over the teachings of Nagamatsu and Kodaira.

In addition, claims 2-7 and 9 depend, either directly or indirectly, from independent claim 1, and are therefore allowable based on their respective dependence from independent claim 1, which is believed to be allowable.

In view of the above amendments to the claims and remarks, Applicants respectfully submit that claims 1-7 and 9 clearly define the present invention over the references relied on by

the Examiner. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 are respectfully requested.

Conclusion

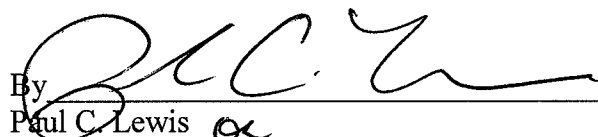
All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Paul C. Lewis, Registration No. 43368 at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: **September 10, 2010**

Respectfully submitted,

By 
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